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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,000	04/26/2001	Frank Charles Pagano	Rev 98-25	7885
26807	7590	05/03/2010		
Joy S. Goudie			EXAMINER	
REVLOX CONSUMER PRODUCTS CORPORATION			PURDY, KYLE A	
237 PARK AVENUE			ART UNIT	
NEW YORK, NY 10017			PAPER NUMBER	
			1611	
			NOTIFICATION DATE	
			DELIVERY MODE	
			05/03/2010	
			ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

joy.goudie@revlon.com

Office Action Summary

Application No.

09/843,000

Applicant(s)

PAGANO ET AL.

Examiner

Kyle Purdy

Art Unit

1611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61, 64, 66, 68, 83-85, 87 and 88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61, 64, 66, 68, 83-85, 87 and 88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-85/86)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Status of Application

1. The Examiner acknowledges receipt of the amendments filed on 1/22/2010 wherein claim 61 has been amended. Claims 81, 82 and 86 have been cancelled.

2. Claims 61, 64, 66, 68, 83-85 and 87-88 are presented for examination on the merits. The following rejections are made.

Noncompliance

3. Applicants response filed on 01/22/2010 is not compliant with 37 CFR 1.121 (c) because Applicant has failed to provide a complete listing of the status of all of claims 1-88. It's noted that claims 62, 63 and 69-80 are missing from the claim set. Correction is required. Applicants' cooperation is requested in complying with 37 CFR1.121 (c) in subsequent amendments in order to avoid delays in the interest of compact prosecution.

Response to Applicants' Arguments

4. Applicants arguments filed 1/22/2010 regarding the rejection of claims 81, 82 and 86 made by the Examiner under 35 USC 103(a) over Strella (US 3928656) in view of Ohno (US 5854365) and Perronin et al. (US 3991007) have been fully considered and they are found persuasive. This rejection has been overcome by cancellation of the claims.

5. Applicants arguments filed 1/22/2010 regarding the rejection of claims 61, 64, 66, 68, 83-85 and 87-88 made by the Examiner under 35 USC 103(a) have been fully considered and they are not found persuasive. This rejection has been overcome by amendment to the claims.

New Rejections, Necessitated by Amendment
Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 61, 64, 66, 68, 83-85 and 87-88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strella et al (3,928,656; of record) in view of Smith et al. (US 6270214;

filed 04/29/1998), Ziolo (US 5858595; published 01/12/1990) and Perronin et al (3,991,007; of record) as evidenced by US 5,798,426 (of record).

10. Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment- 0.8%) (see example 1 and preparation of toner, column 9; see instant claim 61, 64 and 66). The ionic polymer disclosed is butyl methacrylate-acrylic copolymer (94.2/5.8) with a TG of 46 degrees Celsius (see examples II and VIII; see instant claim 61). Strella teaches the use of a pigment or dye such as carbon black, a commercial red, blue, or yellow dye, or any other well-known pigment in an amount of 1-20% (see column 6, lines 4-16; see instant claim 87).

11. Although Strella teaches pigments in the composition, the instant pigments are not specified. Further, the instant solvents, the inclusion of nitrocellulose, a plasticizer and montmorillonite minerals are not taught.

12. Smith is directed to ink jet printing compositions. It's taught that compositions are to comprise dyes or pigments that have been treated with silicone (i.e. siloxane) polymers (see column 1, lines 5-25). The pigment and the silicone complex together to provide improved toner fixation. Exemplified dyes/pigments include FD&C colors (see column 21, lines 1-15; see instant claim 61).

13. Ziolo is directed to magnetic toner and ink jet compositions. It's taught that montmorillonite clay is provided in toner composition to achieve the desired developer viscosity (see column 17, lines 30-45; see instant claim 61).

14. Perronin discusses the importance of pigments in many fields such as textiles, plastics, inks, textiles, and cosmetics (see column 1, lines 10-12). Perronin teaches examples of monomers which may be used in the process include 1) alkene-mono- or di-carboxylic acids, preferably the acids containing up to five carbon atoms, for example acrylic, methacrylic, etc.; 2) esters of these acids, such as methyl, ethyl, butyl, etc. (see column 3, lines 40-60; see instant claim 61). The solvents may be selected from gasolines, aromatic hydrocarbons such as benzene, toluene, xylene, halogenated hydrocarbons such as trichloroethylene, perchloroethylene, chlorobenzene, trichlorobenzene, chlorofluoromethanes, chlorofluoroethanes, alcohols such as methanol, ethanol, n-propanol, l-methyl-ethanol, n-butanol, 2-methyl-propanol, 1,1-dimethyl-ethanol, ketones such as 2-propanone, 2-butanone, 4-methyl-2-pentanone, esters such as ethyl acetate, propyl acetate, 1-methyl-ethyl acetate, ethers such as diethyl ether, ethylpropyl ether, tetrahydrofuran, and 1,4-dioxan (see column 2, lines 45-61; see instant claim 61).

15. Example 6 provides a composition (composition D) with 100 parts a pigment, 350 parts heptane, 90 parts methyl methacrylate, and 10 parts acrylic acid. 190 parts of composition D is then combined with 86 parts of 50% nitrocellulose resin in butyl acetate, 210 parts ethyl acetate (ester solvent), 22 parts butanol, 155 parts isopropanol, and 28 parts butyl phthalate (plasticizer) (see instant claim 61). It is taught that nitrocellulose enhances the coloristic development of the pigmented ink (see column 7, line 55).

16. US 5,798,426 discloses BMA/AA (90/10) has a weight of 69,400 (see instant claims 83 and 84).

17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Strella, Smith, Ziolo and Perronin and substitute

tetrahydrofuran with the claimed solvents such as isopropanol, ethyl acetate and so on. One would have been motivated to do so since Perronin teaches tetrahydrofuran and the claimed solvents are utilized as the organic solvents for the copolymers. Regarding the inclusion of the instantly claimed pigments, they are obvious. Smith teaches that silicone treated pigments are preferred in toner compositions because they adhere better to the surface being applied to. One would have been motivated to include nitrocellulose into the pigmented composition in order to enhance the coloristic development of the final formulation. With respect to the inclusion of montmorillonite, this is obvious. Any person would have been motivated to include such a mineral into a toner composition to adjust the viscosity of the formulation to that desired. With regard to the functional limitations (i.e. a nail enamel) of the instant claims, it is the position of the Examiner that Strellas and Perronin's composition is capable of leaving a water-insoluble film on the nail since the compositions are substantially similar. With regard to the copolymers molecular weight, the Examiner cites US 5,798,426 as art of interest wherein '426 states that BMA/AA (90/10) has a weight of 69,400, which reads on about 68,000. Therefore, a composition comprising a solvent, a silicone treated pigment and FD&C color, a plasticizer, nitrocellulose, montmorillonite and a copolymer of butyl methacrylate-acrylic acid is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
April 21, 2010*

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/David J Blanchard/
Primary Examiner, Art Unit 1643